Supreme Court, U.S.
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No. 05-1360

In the Supreme Court of the United States

BERNARD F. DEPALMA,

Petitioner,

v.

NIKE, INC., BAUER NIKE HOCKEY, INC., AND BAUER NIKE HOCKEY USA,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY BRIEF

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Petitioner Bernard F. DePalma ("DePalma") submits this brief in reply to the brief of respondents Nike, Inc., Nike Bauer Hockey, Inc., and Bauer Nike Hockey USA (together "Bauer") opposing the petition for certiorari.

In revisiting the history of the case prior to Bauer's motion for summary judgment in the district court and arguing that DePalma had ample opportunity to respond to Bauer's *motions*, *viz.*, their initial summary judgment motions (which were denied),[1] as well as their later motion following which the district court granted summary judgment (Resp. Br. at 1-4), Bauer evasively misses the point of DePalma's petition and, therefore, fails to address the importance of the questions raised by this case.

The questions raised by DePalma's petition are premised upon the district court's failure to notify DePalma of the grounds upon which it ultimately granted summary judgment *sua sponte* against DePalma, *not* upon whether DePalma had adequate opportunity to address the points raised in Bauer's motion.

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[1] Bauer's effort to paint DePalma as a dilatory litigant saved only by the compassion of the court (Resp. Br. at 2), is directly belied by the very record cited by Bauer. There, Second Circuit Judge (previously, presiding District Judge) Pooler found the magistrate's order, forbidding DePalma to respond to Bauer's first set of summary judgment motions, to have been an abuse of discretion in view of Bauer's recalcitrance in discovery and DePalma's counsel's reasonable belief that the time to respond to Bauer's initial motions had been extended pending Bauer's compliance with its discovery obligations. It ordered that Bauer comply with discovery, and denied Bauer's summary judgment motions without prejudice to renew, which they did but on different grounds. "Ct. App. JA" at 103-14.

Bauer's contentions (Resp. Br. at 3) that DePalma did not proffer a construction of his patent claim as excluding the "element" that the district court, without prior notice, imported into the claim and ultimately found absent from Bauer's protective shoulder garments as its ground for summary judgment of non-infringement, emphasizes the importance of the questions presented to this Court and the appropriateness of this case as a vehicle for resolving them.[2] DePalma could not have anticipated the district court's ground of non-infringement, not only because Bauer did not raise the ground in their summary judgment motion but, also, because it was based upon an element or "limitation" not expressed in the patent claim but, rather, improperly imported into the claim from the drawings. While there are scores of detailed properties depicted in the drawings and described in the specification of the DePalma patent that the district court might have erroneously imported into the claim to support its judgment of non-infringement, DePalma had no prior notice of the one upon which the district court would ultimately rely.[3]

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[2] DePalma proffered a proper construction of his entire patent claim, including each of the elements expressly recited in claim 1 of his patent, as well as specifically rebutting the five grounds of alleged non-infringement based upon the construction proffered by Bauer on its motion, both in the district court an on appeal.

[3] Bauer's contentions (Resp. Br. at 3-4 and 4-5), that the district court ultimately based its summary judgment on the claim elements argued by Bauer in their motion, is simply untrue. The portions of the joint appendix cited by Bauer (*id.* at 4) in no way support their attempt to take credit for arguing the grounds upon which summary

Having confidence in their efforts to mislead the Court in that regard, Bauer made no effort whatsoever to rebut DePalma's showing that his petition raises important questions

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judgment was ultimately based. The section of Bauer's summary judgment motion to which they cite relates to one of Bauer's proffered bases of non-infringement (each of which the district court rejected at 27a - 30a), *viz.*, that their garments were not in the form of a shirt, vest, or similarly recognized wearing apparel:

> Specifically, none of these pads include a shirt or vest that conforms to the wearer's upper body. As such, none of these models literally infringe claim 1 of the '801 patent. Both Professor Pearsall and Mr. Bourque observed that the accused models have no shirt or vest, as required by the '801 [DePalma] patent. This distinction is apparent from a review of the '801 patent drawings.... *[T]he garment aspect of the accused [Bauer] models clearly is not a shirt or vest* conforming to the wearer's body. ["Ct. App. JA" at 137-40 (emphasis added)]

That is precisely how the district court understood Bauer's argument, rejecting their proffered narrow claim construction and ground of non-infringement:

> The Court does not read the 801 patent as limited specifically to "shirt" or "vest." As the Court reads the claims, specifications, and prosecution history, the requirements regarding the form of the body covering means, or garment, relate to its function.... [Petition Appx. at 30a]

Indeed, Bauer's admission that their products did have a "garment aspect," but that it was merely not a shirt or vest, in no way anticipated the district court's determinations that body-covering material, in addition to that forming the garments' pockets, was required by the patent and completely absent from Bauer's products.

regarding the procedural safeguards of our Fifth and Seventh Amendment rights as secured in FED.R.CIV.P. 56. Nor did Bauer even discuss the cases cited by DePalma which demonstrate a split in the circuits on the questions raised, cite any cases of their own, nor venture an explanation why these important questions should not be resolved by this Court. See Resp. Br. at 5.

Bauer then devotes a substantial part of its brief justifying the practice of consolidating a *Markman* hearing construing the patent claims with a motion for summary judgment of non-infringement. Resp Br. at 6-7. But the district court in this case neither merged a *Markman* claim construction hearing into the summary judgment motion nor otherwise construed DePalma's patent claims prior to rendering summary judgment, pursuant to *Markman* or otherwise. If it had done so, thereby giving the litigants prior notice of the legal claim construction upon which it would grant summary judgment, there would have been little surprise to DePalma and his case, in all probability, would not now be before this Court.

Finally, Bauer mischaracterizes DePalma's position in seeking review of the Federal Circuit rules that permit unpublished decisions and judgments without opinion, as requiring the direct application of new F.R.A.P. 32.1, effective January 1, 2007, to this case. That is hardly DePalma's position. Whether those local rules were applied here in anticipation of the new rule permitting citation to unpublished decisions, thereby proliferating no-opinion judgments in circumvention of the new rule permitting citation of unpublished opinions, or were simply means to sweep an inconsistent and unsupportable decision under the rug, this Court's supervisory role is implicated. While a lawyer should, indeed, be able to tell a court what it did, the lawyer must first know what the court did.

For the foregoing reasons, and for the reasons set out in his petition, it is respectfully submitted that DePalma's petition for a writ of certiorari be granted.

Respectfully submitted,

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